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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,096	04/01/2005	Masashi Kudo	121036-0078	5558

7590 11/30/2007

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EXAMINER	
PENG, KUO LIANG	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
11/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/530,096	KUDO ET AL.	
	Examiner	Art Unit	
	Kuo-Liang Peng	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/3/07 Amendment*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-10,15-18,32 and 34* is/are pending in the application.

4a) Of the above claim(s) *2-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-18, 32, 34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The Applicants' amendment filed October 3, 2007 is acknowledged. Claims 1, 11-14, 19-31 and 33 are deleted. Claims 16-18 and 32 are amended. Claims 2-10 are withdrawn. Claim 34 is added. Now, Claims 15-18, 32 and 34 are pending for consideration.

2. Claim objection(s) in the previous Office Action (Paper No. 062307) is/are removed.

3. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 062307) is/are removed.

4. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 34 (line 3), it is not clear as to how tight/low the terms "tight" and "low" refer to.

Claim Rejections - 35 USC § 103

7. Rejection of Claims 15-19 and 32 under 35 USC 103(a) as being unpatentable over Bentz (US 5 922 991) in view of JP255 (JP 2000-154255) is maintained because the rejection is adequately set forth in paragraph 9 of Paper No. 062307. The newly added Claim 34 can be rejected over the similar ground. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 8, 2nd paragraph to page 9, 2nd paragraph and page 10, 1st paragraph to 1st paragraph), Examiner disagrees. Bentz teaches a method of preventing contact breakage of a wiring harness due to **vibration** in automobile **engines** by utilizing an arrangement for mounting a

wiring harness on a support plate where at least a portion of the wiring harness is **sealed** with a sealing medium. (col. 1, lines 11-16 and 44-52) As such, Bentz clearly recognizes the well-known **vibration problem**. Bentz further teaches the use of a sealing material to **seal** the harness in the arrangement. JP255 teaches a sealing material having **vibration absorption** capability for using in automobile **engines**. ([0086]) The combination of the prior art components would have yielded the **PREDICTALBE RESULT** of lessening the adverse effect of vibration. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize JP255's **vibration absorbing** sealing material in Bentz's arrangement with expected success. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

For Applicants' argument (Remarks, page 9, 3rd to 5th paragraphs), Examiner disagrees because the strain relief is merely one of the issues mentioned by Bentz. As a whole, Bentz also deals with the vibration issue, *supra*.

For Applicants' argument (Remarks, page 10, 2nd paragraph to page 11, 4th paragraph), Examiner disagrees because of the following reasons: First, the specific unexpected characteristics are vague because of the reason similar to that set forth in paragraph 6 of the instant Office action. Second, these unexpected characteristics over the combination of Bentz and JP255 are merely **opinions**.

Applicants are further reminded that the arguments of counsel cannot take the place of **evidence** in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) Third, *In re Shetty* cited by Applicants does not appear to be exactly applicable here because of the following reason: For *In re Shetty*, court held that claimed method might be inherent in teachings of prior art is immaterial if one of ordinary skill in art would not appreciate or recognize that inherent method; mere hindsight assertion that corresponding dosages of prior art compounds useful for combating microbial infestation, in light of which claimed compound is obvious, renders claimed method for appetite control obvious untenable; inherency of advantage and its obviousness are entirely different questions; obviousness cannot predicated on what is unknown. Clearly, In *In re Shetty*, the question at issue is whether a **claimed compound** as being an obvious variant of an **antiviral** compound disclosed in prior art will render a **claimed method** of administering the compound in an amount **effective** to **appetite** control obvious or not. Therefore, *In re Shetty* pertains to the relationship between a **compound** and a **method** of using the compound, i.e., the inherency of utilizing a compound known to be useful for one application in a method of using the compound in a **different** application. To the contrary, the issue related to the present rejection is whether a **claimed compound** that is obvious over the prior art

inherently possesses the **claimed properties** thereof. Thus, Examiner believes that *In re Shetty* is immaterial, and Applicants' argument with respect to the inherent properties is lack of merit.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
November 28, 2007

Kuo-Liang Peng
Primary Examiner
Art Unit 1796